

REMARKS

Claims 1 to 15 were pending in the application at the time of examination. Claims 1 to 15 stand rejected as obvious.

Prior to considering the obviousness rejection in detail, Applicants respectfully note that in an obviousness rejection the MPEP requires:

**V. < DISCLOSED INHERENT PROPERTIES ARE PART OF "AS A WHOLE" INQUIRY**

"In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. **In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification.** (Emphasis Added.)

MPEP § 2141.02, 8th Ed. Rev. 3, pg. 2100-132 (August 2005).

The Specification disclosed, for example, at least at page 6, lines 27 to 34.

The retrieval of version 220 is independent of the status of version of 221. In particular, if current version 221 can no longer be retrieved, e.g., current version 221 inadvertently was erased or became corrupted during a computer system crash, version 220 can be successfully opened and used in contrast to the method of Figure 1, which required the current version to generate all earlier versions.

Thus, when the claims were interpreted as required by the above quoted MPEP section, it was inherent that retrieval of a version was independent of another version stored in the file.

Accordingly, the amendments to Claims 1, 5, 6, 9, and 12 should not affect the patentability of these claims, because according to the MPEP this information must have been considered by the Examiner. Nevertheless, the amendments are made to foreclose any discussion on whether Applicant is asking to have a limitation read into the claims.

Claim 15 is amended to correct informalities.

Claims 1 to 11 remain rejected as being obvious, by U.S. Patent Application Publication No. 2002/0073106 A1, hereinafter referred to as Parker, in view of U.S. Patent No. 6,918,082 B2, hereinafter referred to as Gross.

In the pending rejection as well as prior rejections, the Examiner stated in part:

As per claims 1 and 5-6, Parker et al. teaches "storing said at least one earlier version of said document in its entirety in a file . . ." (see page 6, paragraphs [0154]-[0157]) "storing said current version of said document in its entirety in said file" (see page 6, paragraphs [0154] (Sic) and page 3, paragraphs [0073]-[0076]). . . .

With respect to continuing to cite to Parker, even though Applicant has pointed out that Parker taken as a whole teaches away from Applicant's invention as recited in Claim 1, the rejection stated:

. . . refer applicant to Parker's abstract and paragraph [0006] which indicates how the various versions are stored as implied in applicant's claim language.

Applicant continues to respectfully traverse the obviousness rejection of Claim 1. As previously noted the MPEP requires "The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." The Abstract of Parker stated:

. . . comparing the current version of a changed file to the last previous on-site version of the changed file, computing the differences between the two versions by different forward and reverse algorithms to provide a forward delta and a reverse delta, **storing the current version and the reverse delta of the changed file on-site while deleting the last previous on-site version of the changed file**, permanently storing off-site the forward

deltas of each changed file and a baseline copy of each new file, restoring any requested file, if on-site, by recovering the current version and subtracting the appropriate reverse deltas therefrom until the requested file is produced, or, if off-site, by recovering the baseline version and adding the appropriate forward deltas thereto until the requested file is reproduced. (Emphasis Added.)

The Abstract teaches nothing about storing two versions of a document in a single file. In fact, a document is not even mentioned. Further, the Abstract teaches or suggests nothing about how the delta and the current versions are stored, except that they are stored either on-site or off-site.

In contrast, Claim 1 recites:

storing said at least one earlier version of said document in its entirety in a file on said storage medium;  
and

storing said current version of said document in its entirety in said file (Emphasis added)

As noted above, first two files are used by Parker and so Parker teaches away from storing two versions in the same file.

Second, a current version and a delta where taught. Use of a delta teaches away from storing a version in its entirety as recited in Claim 1.

Further, Parker explicitly stated that both the current version and the delta had to be used to restore a requested file. In contrast, Claim 1 recites:

retrieval of said at least one earlier version for said subsequent use is independent of a status of said current version

As quoted above from the Abstract of Parker, Parker could not do the retrieval if either the delta or the current version were missing or damaged. Accordingly, Parker is dependent on the status of both the current version and the delta and so

further teaches away from Applicant's Claim 1. Accordingly, the reliance on the Abstract to maintain the rejection based on Parker is not well founded.

In addition, Paragraph [0006] of Parker stated:

[0006] It is a further object of the present invention to detect the precise changes made to a prior file in the system and then save the changes. An important step in this process is **computing the differences between the two previous and current versions to provide a forward delta and a reverse delta, and, then, storing the current version and the reverse delta of the changed file onsite while deleting only the last previous on-site version of the changed file, and permanently** storing off-site the forward delta of the changed file and a baseline copy of each new file. This process preferably uses different forward and reverse algorithms to compute the forward and reverse deltas. (Emphasis added)

This teaches nothing more than was noted above with respect to the Abstract and so the above comments with respect to the Abstract are directly applicable to this paragraph also and so will not be repeated.

Next, the rejection stated:

Gross teaches "wherein said at least one earlier version and said current version are both in said file for subsequent use" (see col. 2, lines 50-67 and col. 3, lines 1-9).

This section of Gross stated:

The disclosed prior art systems and methodologies provide methods for the delivery of portable format documents over computer networks, but fail to provide a way to automatically display or track multiple versions of the electronic documents, to review and add to a history of comments about the particular version of the document displayed, to alter the current/preferred version of the document, or to simultaneously-display a particular document version and its current history. Nor do the disclosed prior art systems enable these capabilities for

simultaneously managing multiple different projects and documents.

#### SUMMARY OF THE INVENTION

Accordingly, it is an object of the invention to provide a system which simultaneously displays multiple versions of portable format document over a computer network.

Another object of the invention is to provide a system enabling a collaborative reviewer to change a current version of a portable format document.

Still another object of the invention is to provide a system for simultaneously displaying a history of comments from collaborative reviewers together with each version of a portable format document.

This section of Gross teaches nothing concerning the storage of different versions of a document and instead discusses display of the document. Accordingly, the cited section fails to support the conclusions in the rejection.

Further, when Gross is considered as a whole, Gross also teaches away from the conclusion of the rejection. In Fig. 3, Gross shows that different versions of a document are stored as two files in two different directories, e.g. one version of MyFile 100 is stored in version one of directory 98 and another version of MYFile 101 is stored in version two of directory 98. This explicitly demonstrates that the two versions of the document are stored as separate files in different directories and so teaches away from Applicant's invention as recited in Claim 1.

Gross explicitly described this by stating:

One or more client directories **94** are created in root **92**. The dots ". . ." indicate that there are multiple other possible **directories**. As alluded to above, a client is a unique group/collection of proofer. In this regard, it is understood that members of a client group may each have the same or different proofer identifiers.

Each client **94** may be assigned multiple proofing projects **96** each of which is created in a separate directory. Whenever a document version is uploaded to

computer 60 directories 94 and 96 are created if they do not already exist, a version number is assigned to the document and a version directory 98 is created if necessary to store the document version. In the illustrated example, Client 1's Project 1 includes three different documents: MyFile, MyFile 1 and MyFile 2. The document named MyFile exists in two versions 100 and 101. The document named MyFile 1 exists in a single version 102. And the document named MyFile 2 exists in two versions 103 and 104. Thus, these three documents comprise five different document versions. It is understood that although not necessary to the invention, a project identifier is also sent to computer 60 when creator 56 uploads a document version.

When a proofer requests a document version, the URL is assembled by combining the protocol and host "<protocol>://<host>" together with the directory tree structure assembled from the information about the document version "<client>/<version>/<name>". The complete URL takes the form "<protocol>://<host>/<client>/<project>/<version>/<name>/" . Other specific forms are possible for the URL, but by setting up the directory tree with some information about the document and by formulating the URL from the directory tree, the URL also provides information about the document.

Gross, Col. 5, lines 33 to 65.

Accordingly, the interpretation of Gross is not supported by the reference. Since the interpretation given of the two references is not supported by the references and the two reference taken together fail to suggest Applicant's invention as recited in Claim 1. These facts alone are sufficient to overcome the obviousness rejection.

The motivation for the combination in the final rejection was:

It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Gross and Parker above, because using the steps "wherein said at least one earlier version and said current version are both in said file for subsequent use" would have given those skilled in the art the tools to store/process/display current or earlier

versions of document in an individual file simultaneously.. This gives users the advantage of manipulating the versions of various documents in a more efficient manner.

Again, this motivation cites no teaching in the prior art to support the conclusions and instead uses Applicant's claim language.

The MPEP directs:

**THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION**

MPEP § 2143.01, 8th Ed., Rev. 3, pp 2100-135 (August 2005).

The motivation provided is not based on any citation to the prior art and so the rejection has failed to establish that the prior art suggests the desirability of the claimed invention. Accordingly, a proper basis for the motivation has not been established. This is further evidenced by the MPEP requirement:

**FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

MPEP § 2143.01, 8th Ed., Rev. 3, pp 2100-137 (August 2005).

The two cited references establish the level of skill in the art and Parker teaches that the motivation is not well founded. In particular, Parker stated:

It is an object of the present invention to use minimum storage on-site and offsite by storing only a baseline version of a document offsite with all forward deltas and saving only the current version of the document

on-site with all reverse deltas. The volume and time to transmit data to offsite storage and back to the on-site host is kept to a minimum. (Emphasis added.)

Parker, paragraph [0005]

One of skill in the art in viewing Parker would be looking to use minimum storage. Storing two versions goes against minimizing storage. It also goes against the explicit teaching of storing only a single version and deltas, as discussed above. Accordingly, one of skill in the art, in view of Parker would not have the motivation used in the rejection. This is further evidence that the references have not been considered as a whole.

In addition, the MPEP directs:

**< THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP § 2143.01, 8th Ed., Rev. 3, pp 2100-137 (August 2005).

As noted above storing two files instead of one would render Parker unsatisfactory for its intended purpose of minimizing storage. Accordingly, even if the Examiner disregards Applicant's remarks concerning the teaching of the references. The MPEP requirements demonstrate that the combination is improper and so a prima facie obviousness rejection has not been established.

Accordingly, the obviousness rejection is not well founded for multiple reasons, any one of which is sufficient to overcome the rejection. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 1.



Claims 2 to 4 depend from Claim 1 and so distinguish over the combination of references for at least the same reasons as Claim 1. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 4.

With respect to the obviousness rejection of Claim 5, the above comments concerning Parker and Claim 1 are incorporated herein by reference. Also, Paragraph 76 of Parker, as quoted above, describes encrypting both the delta and the file. First, as noted with respect to Claim 1, this teaches away from storing both versions in their entireties. Second, the delta and file are both encrypted which teaches away from storing in different forms as in Claim 5. Accordingly, Claim 5 distinguishes over the combination of references for multiple reasons. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 5.

Claim 6 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 6 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 6.

Claims 7 to 8 depend from Claim 6 and so distinguish over the combination of references for at least the same reasons as Claim 6. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 7 to 8.

Claim 9 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 9 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 9.

Claims 10 to 11 depend from Claim 9 and so distinguish over the combination of references for at least the same reasons as Claim 9. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 10 to 11.

Claim 12 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 12 and are incorporated herein by reference.

Applicant submits that Claim 12 distinguishes over the combination of references. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 12.

Claims 13 to 15 depend from Claim 12 and so distinguish over the combination of references for at least the same reasons as Claim 12. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claim 13 to 15.

Claims 1 to 15 remain in the application. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

Respectfully submitted,

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 9, 2006.



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January 9, 2006  
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